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10/730,223

12/05/2003

Gregory T. Huber

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/730,223

Applicant(s)

HUBER ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,16-22 and 24-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,16-22 and 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/13/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 12/19/06.

The new grounds of rejection set forth below are necessitated by applicants' amendment and thus, the following action is final.

Information Disclosure Statement

2. Applicants' IDS filed 9/13/06 has been considered. It is noted that GB 1424517 has been stricken from the IDS as redundant given that it is also cited on the PTO-892 mailed with the office action of 9/19/06.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 25 has been amended to recite "said dispersant is present in about 10 wt.% based on the weight of the colorant". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written

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description requirement of the cited phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for such amendment, applicants point to example 8 of the present specification. However, while this example, as well as page 6, lines 10-12 of the present specification, provide support to recite that the dispersant is present in amount of about 10 wt.% based on the weight of pigment, there is no support to recite that the dispersant is present in amount of about 10 wt.% based on the weight of colorant which includes dye given that there is no support to recite that the dispersant is present in amount of about 10 wt.% based on the amount of dye.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-10, 16-22, and 24-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1424517 in view of GB 1108261.

The rejection is adequately set forth in paragraph 9 of the office action mailed 9/19/06 and is incorporated here by reference.

7. Claims 1-10 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 7,056,962).

The rejection is adequately set forth in paragraph 10 of the office action mailed 9/19/06 and is incorporated here by reference.

Response to Arguments

8. Applicants arguments filed 12/19/06 have been fully considered but they are not persuasive.

Specifically, applicants argue that there is no motivation to combine GB 1424517 with GB 1108261 given that GB 1108261 is referenced in GB 1424517 only for its description of polyalkylene oxides at page 2, lines 26-28 and thus, there is no motivation for looking at other parts of GB 1108261 in that the dispersant of GB 1108261 is quite different from that of GB 1424517.

However, attention is drawn to page 1, lines 12-23 of GB 1424517 that discloses pigment dispersion comprising polymeric colored dispersant of the formula $D-(Z-R)_n$ where D is dyestuff, Z is divalent bridging group including those possessing O or N, n is 1-8, and R is polymer, page 1, lines 44-45 of GB 1424517 that discloses that the polymer is an addition polymer, and to page 1, lines 68-75 of GB 1424517 that discloses that "suitable" addition polymer includes not only polyalkylene oxides as disclosed in GB 1108261 but especially polymers and copolymers of ethylenically unsaturated monomers examples of which are found on page 3, lines 39-91 of GB 1108261. Thus, while it is agreed that GB 1424517 refers to GB 1108261 for its use of polyalkylene oxides, it is significant to note that GB 1424517 also refers to GB 1108261 for its disclosure of polymers that include hydrocarbon such as polyisobutylene.

Thus, it is the examiner's position that there is proper motivation to combine GB 1424517 with GB 1108261.

Applicants also argue that the rejection of record utilizing Johnson et al. is based on hindsight given that while Johnson et al. disclose modified pigment that includes polymer, the polymer includes not only hydrocarbons as presently claimed but also polymers outside the scope of the present claims with no motivation for one of ordinary skill in the art to choose material similar to that presently claimed. Applicants also argue that there are no examples in Johnson et al. falling within the scope of the present claims.

However, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

It is noted that Johnson et al. disclose modified pigment comprising the structure pigment-X-polymer[R] which corresponds to presently claimed A-(B-X)_n when n is 1 and wherein pigment, which corresponds to A, is carbon black or organic pigment, X, which corresponds to B, is linking moiety that is alkyl or aromatic group substituted with ether or amide group, and polymer[R], which corresponds to X, is obtained from 1-500 repeating units and includes polyethylene, polyisobutylene, or polystyrene. While it is agreed that Johnson et al.

disclose that the polymer includes not only hydrocarbon as presently claimed but other polymers outside the scope of the present claims, the fact remains that Johnson et al. explicitly disclose the use of polymer that is hydrocarbon, i.e. polyethylene, polyisobutylene, or polystyrene, as presently claimed. Therefore, it therefore would have been obvious to one of ordinary skill in the art to choose polymer, including hydrocarbon as presently claimed, to produce modified pigment with desired properties depending on the end use, and thereby arrive at the claimed invention.

Further, while it is agreed that there are no examples in Johnson et al. that fall within the scope of the present claims, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others”, *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of Johnson et al. as a whole clearly discloses use of pigment comprising the structure pigment-X-polymer[R] which corresponds to presently claimed $A-(B-X)_n$ and thus, it is the examiner’s position that Johnson et al. is a proper reference against the present claims.

Applicants also argue that Johnson et al. disclose pigment not dispersant as presently claimed. However, while there is no disclosure that the modified pigment of Johnson et al. is a dispersant as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended

use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. dispersant, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art modified pigment and further that the prior art structure which is identical to that set forth in the present claims is capable of performing the recited purpose or intended use and thus, one of ordinary skill in the art would have arrived at the claimed invention.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
3/18/07